

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 060258-0280240									
		Application Number 09/835,821	Filed April 17, 2001								
		First Named Inventor EIKKULA, Jari									
		Art Unit 2619	Examiner MAIS, Mark								
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).        Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table> <tr> <td><input type="checkbox"/> applicant /inventor.</td> <td>/Larry J. Hume/ Signature</td> </tr> <tr> <td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td> <td>Larry J. Hume Typed or printed name</td> </tr> <tr> <td><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>44,163</u></td> <td><u>703.770.7981</u></td> </tr> <tr> <td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</td> <td>Telephone number <u>July 21, 2008</u> Date</td> </tr> </table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.        Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>				<input type="checkbox"/> applicant /inventor.	/Larry J. Hume/ Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Larry J. Hume Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>44,163</u>	<u>703.770.7981</u>	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____	Telephone number <u>July 21, 2008</u> Date
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<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____	Telephone number <u>July 21, 2008</u> Date										

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re PATENT APPLICATION of: Confirmation Number: 5540

JARI EIKKULA

Application No.: 09/835,821

Group Art Unit: 2619

Filed: April 17, 2001

Examiner: MAIS, Mark A.

Title: PROVIDING A NETWORK NODE WITH SERVICE REFERENCE INFORMATION

**ARGUMENTS SUBMITTED WITH PRE-APPEAL BRIEF CONFERENCE REQUEST**

**MS AF**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In response to the Final Office Action dated February 21, 2008, the period for response having been extended until July 21, 2008 by the accompanying Petition for 2-Month Extension of Time, and concurrent with the filing of the accompanying Notice of Appeal and Request for Pre-Appeal Brief Conference, Appellant submits the following arguments for consideration by the Appeal Conferees.

Claims 1-51 are pending, and claims 1, 15-18, 21, 24, 29-30, 33-36 and 44-49 are independent. Claims 15-18, 24-28, 30-32, 35-36, and 38-43 are allowed, and claims 5-6, 9-10, 19-20, and 23 are indicated as being allowable, and would be allowed if rewritten in independent form.

The claims subject to appeal of the final rejection are claims 1-4, 7, 8, 11-14, 21, 22, 29, 33, 34, 37, and 44-51.

**I. REJECTIONS TO BE REVIEWED UPON APPEAL**

- A. *Anticipation rejection* of claims 1-4, 7-8, 13, 21, 22, 29, 33, 34, and 44-51 under 35 U.S.C. §102(e), as allegedly being anticipated by Yoakum et al (US 6,735,621) ("Yoakum").
- B. *Unpatentability rejection* of claims 11, 12 and 14 under 35 U.S.C. §103(a), as allegedly being unpatentable over Yoakum.

Due to the page limits imposed upon this Request, the Arguments presented herein are directed only to the anticipation rejections of the non-allowed independent claims 1, 21, 29, 33, 34, and 44-49. These arguments are also pertinent to the unpatentability rejection of various dependent claims.

## II. SPECIFIC DEFICIENCIES OF YOAKUM

### A. The Examiner has not met the legal requirements for the anticipation rejection of at least independent claims 1, 21, 29, 33, 34, and 44-49 under 35 U.S.C. §102(e) because Yoakum does not teach or suggest all the claimed limitations.

With respect to the rejection of the independent claims, Yoakum is deficient by not providing any disclosure, teaching, or suggestion of a use of service reference information, including failing to provide any disclosure that even hints that service reference information is delivered in an SIP message.

Yoakum is completely silent on even the existence of *service reference information*, as that term is known in the art, and as discussed in Applicant's disclosure at least in the Abstract ("In order to provide a network node using an IP telephony signalling protocol, such as SIP, with service reference information needed for billing purposes...the service reference information is added to an IP telephony signalling protocol message..."); and at least at p. 1, lines 5-9; p. 2, lines 12-16; p. 2, line 33 through p. 3, line 2; p. 5, line 33 through p. 6, line 10, and lines 25-35.

In addition, the Examiner alleges that Yoakum's Abstract discloses adding SS7 signaling into SIP. To the contrary, Yoakum discloses translating SS7 TCAP messages into SIP INVITE messages. In other words, Yoakum teaches *translating* information from a non-IP protocol format into IP-protocol format so that the whole message is in IP-protocol format, such that a network using SIP can understand the information. In contrast, Appellant adds information in a non-IP-protocol format to a message that is in IP-protocol format, the end result being a message in IP-protocol format that contains information in a non-IP-protocol format.

As a consequence, Yoakum is completely silent on delivering service reference information in a SIP message or in adding such service reference information to a message. The only disclosure of "adding" in Yoakum is provided in the context of adding addresses to a response, via which addresses a service user can be reached (see Yoakum at col. 8:32-34).

Yoakum does not teach or suggest all the limitations of at least the independent claims, as generally discussed above, and as highlighted below, by way of specific example in ***bold, italicized*** text.

### **Independent Claim 1**

Yoakum does not disclose, teach, or suggest a method that includes, *inter alia*, "***adding non-IP telephony signaling protocol service reference information*** to an IP telephony signaling protocol message...," as recited in independent claim 1 (***emphasis*** added).

### **Independent Claim 21**

Yoakum does not disclose, teach, or suggest a communications system providing IP telephony wherein, *inter alia*, "...[a] first network node is arranged to add non-IP telephony signaling protocol **service reference information** relating to a call made to the user equipment to an IP telephony signaling protocol message and to send the IP telephony signaling protocol message to the second network node; and the second network node is arranged to **separate the service reference information from the IP telephony signaling protocol message**," as recited in independent claim 21 (*emphasis* added).

### **Independent Claim 29**

Yoakum does not disclose, teach, or suggest a communications system providing IP telephony, wherein, *inter alia*, "...[a] first network node is arranged to **add first service reference information** relating to a call made to the user equipment to an IP telephony signaling protocol message initiating a session, to ...separate second **service reference information** relating to the call from the SIP response message; and [a] second network node is arranged to separate the first **service reference information** from the IP telephony signaling protocol message initiating a session, to add the **second service reference information** to the response message and to send the response message to the first network node, *wherein the first service reference information is non-IP telephony signaling protocol service information*," as recited in independent claim 29 (*emphasis* added).

### **Independent Claim 33**

Yoakum does not disclose, teach, or suggest a network node in a communications system providing IP telephony, wherein the network node comprises means for **adding non-IP telephony signaling protocol service reference information to an IP telephony signaling protocol message**," as recited in independent claim 33 (*emphasis* added).

### **Independent Claim 34**

Yoakum does not disclose, teach, or suggest a network node in a communications system providing IP telephony, wherein the network node comprises **means for separating non-IP telephony signaling protocol service reference information from an IP telephony signaling protocol message**," as recited in independent claim 34 (*emphasis* added).

### **Independent Claims 44-49**

In addition to not providing any disclosure, teaching or suggestion of the use of **service reference information**, *Yoakum is also completely silent on the use of charge identifiers used in billing*. The

Examiner asserts that Yoakum at col. 1:65 to col. 2:5 discloses this feature. A closer examination of this cited portion of Yoakum reveals an incorporation by reference of an intelligent network (IN) using the Intelligent Network Application Protocol (INAP), purportedly discussed in European Telecommunications Standards Institute (ETSI) publication "ETSI-CORE-INAP-CS2, Intelligent Network Application Protocol, Capability Set 2, March 1996".

The Examiner has not previously provided this reference to Appellant, and Appellant's representative has been unable to locate the document referenced by Yoakum above, which is apparently relied upon by the Examiner in the rejection of independent claims 46-47 and dependent claims 50-51. It is clear that Yoakum, standing alone, does not disclose that for which the Examiner offers it. Yoakum is completely silent on INAP providing a non-IP charging/billing identifier for inter-network compatibility between SS7 and SIP. Thus, there is no basis for the Examiner's argument.

Furthermore, upon information and belief, Appellant submits that INAP billing operations may not be supported across the Service Provider interface to prevent misuse, and that certain usage of the INAP protocol (e.g., Service Control Function – SCF - and Service Switching Function – SSF) can cause billing inaccuracies, or create problems for downstream billing systems, affecting customer or interadmin billing.

Accordingly, to ensure that the record is clear going forward on Appeal, Appellants respectfully request that the Examiner identify precisely where in Yoakum or in the ETSI Publication referenced therein that disclosure is provided for Appellant's recited "charge identifiers used in billing."

By way of specific deficiencies with respect to independent claims 44-49, Yoakum does not disclose, teach, or suggest "a processor configured to **add non-IP telephony signaling protocol service reference information to an IP telephony signaling protocol message**" (independent claim 44); "a processor configured to **separate non-IP telephony signaling protocol service reference information from an IP telephony signaling protocol message**" (independent claim 45); "a processor configured to **separate a charging identifier to be used in billing as charging correlation information from an SIP message**" (independent claim 46); "a processor configured to **generate a charging identifier to be used in billing as charging correlation information and to add at least the charging identifier to an SIP message**" (independent claim 47); "a computer readable medium having a computer-executable software routine comprising **adding non-IP telephony signaling protocol service reference information to an IP telephony signaling protocol message**" (independent claim 48); and "a computer readable medium having a computer-executable software routine comprising **separating non-IP telephony signaling**

***protocol service reference information from an IP telephony signaling protocol message"***  
(independent claim 49), (***emphasis*** added).

Accordingly, reversal of the Examiner and allowance of independent claims 1, 21, 29, 33, 34, and 44-49 are requested. In addition, dependent claims 2-14, 19-20, 22-23, 37, and 50-51 variously and ultimately depend upon patentable independent claims 1, 21, and 33, and are submitted as being allowable at least on that basis, without further recourse to the additional patentable features recited therein.

### **III. ADMINISTRATIVE OVERSIGHT IN THE FINAL OFFICE ACTION**

There is an administrative inconsistency in the rejection of dependent claim 51, which has been rejected as allegedly being anticipated by Yoakum under 35 U.S.C. §102(e). However, claim 51 depends from claim 37, which has been rejected as being unpatentable over Yoakum under 35 U.S.C. §103(a). Accordingly, correction of the basis for rejection of claim 51 is respectfully requested to ensure that the record is complete and unambiguous going forward on Appeal.

### **IV. CONCLUSION**

In view of the above-identified deficiencies of Yoakum, reversal of the Examiner by the Appeal Conferencees and allowance of all pending claims 1-51 in this Application are respectfully requested.

Date: July 21, 2008

Respectfully submitted,

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Attachments: Notice of Appeal  
Petition for 2-Month Extension of Time  
Request for Pre-Appeal Brief Conference